

### **REMARKS**

Claims 1, 3-8, 11-13, 15-19, 21-27, 30, and 32-34, as amended, are pending in this application. In this response, Applicants have amended claims 1 and 30 to further clarify the embodiments featured therein. In addition, several dependent claims have also been amended. Finally, claim 21 has been canceled. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents. As no new matter has been added by the amendments herein, Applicants respectfully request entry of these amendments at this time.

### **THE OBJECTION TO THE CLAIMS**

The Examiner objected to claim 21 for being dependent from a canceled claim. Applicants appreciate the Examiner's bringing this oversight to Applicants' attention. In light of the cancellation of this claim, Applicants submit that the objection is moot.

### **THE REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner rejected claims 1, 3-8, 11-13, 15-19, 21-27, 30, and 32-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the reasons set forth on pages 2-4 of the Office Action. In light of the amendments to claims 1, 27, and 30, Applicants submit that the Examiner's rejection is moot.

In addition, claims 21 and 24-27 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Office Action at Page 3. In response, claim 21 has been canceled. In addition, regarding the Examiner's rejection of claims 24-27, Applicants have amended claims 24-27 to provide proper antecedent basis.

In light of the foregoing, Applicants request reconsideration and withdrawal of the 35 U.S.C. § 112 rejections based thereon.

### **THE REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1, 3-8, 11-13, 15-19, 21-27, 30, and 32-34 were rejected under 35 U.S.C. § 103(a) as being obvious over various combinations of U.S. Publication No. 2002/0077956 to Solheim (“Solheim”), U.S. Patent No. 6,182,897 to Knowles (“Knowles”), a collection of archived webpages:

<http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>;  
<http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>;  
<http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; and  
<http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>

(collectively “Callaway”), “Letters by Duchess of Windsor, Prince to Be Published; [Home Edition]”. Los Angeles Times (pre-1997 Fulltext). Los Angeles, Calif.: Apr 26, 1986, pg. 6) (hereinafter referred to as “Mehren”), U.S. Publication No. 2004/0054888 to Chester (“Chester”), “Scrutinizing the numbers” InfoWorld, San Mateo: Aug. 19, 2002, Vol. 24, Iss. 33, pg. 35 (“Harreld”), and U.S. Publication No. 2003/0171927 to Bernard (“Bernard”). None of the cited references and combinations disclose or suggest the present invention for at least the reasons that follow.

As a threshold matter, Applicants renew and incorporate the previous arguments against Solheim, Callaway, Chester, Harreld, and Bernard. In sum, none of these references disclose or suggest a method for determining the authenticity, alteration status, *and* alteration condition of the golf equipment.

In addition, Applicants submit that the addition of Mehren does not render obvious the present invention. For example, the Examiner cites Mehren for the purported disclosure of an authentication process where a report indicates a forgery. To support this assertion, the Examiner cites a single paragraph describing the report of a handwriting expert that had revealed the Adolf Hitler diaries as a forgery. *See*, page 1, paragraph 11. Not only does this limited disclosure fail to describe a method of authenticating golf clubs, it also is completely devoid of any enabling disclosure. The mere fact that a handwriting expert published a report based on handwriting, signatures, and watermarks in no way would enable a skilled artisan to produce a report that verifies the authenticity, alteration status or alteration condition of golf equipment.

Furthermore, Solheim fails to disclose or suggest a method of determining the authenticity, alteration status, *and* alteration condition of the golf equipment. Rather, the Examiner asserts that “it is implicit that during the manufacturer’s verification of authenticity, the manufacturer would also compare the equipment to the factory specifications to determine conformity.” Office Action at Page 5. However, the Examiner provides no reasoning for this assertion. In fact, a golf club manufacturer could determine the authenticity of a golf club without assessing whether a modification or alteration has been made. For example, a golf club may be imprinted with a certain patent registration number or other distinguishing characteristic. As such, a comparison of the various measurements of the golf club head would not be necessary. Furthermore, Solheim provides that the bidder is given the factory specifications to compare to the description of the seller to determine whether “radical changes” have been made to the golf club. *See, e.g.*, Para [0016]. There is no mention of determining how the club head has been altered (alteration condition). As such, it is the buyer that compares the club to the factory specifications, and the manufacturer does not necessarily compare the product with the factory specifications to determine the alteration condition.

In addition, in light of the limited purpose that the Examiner cited Knowles, Applicants submit that the deficiencies of Solheim have not been overcome. For example, Knowles merely discloses a method of determining the various phases of the manufacturing of a laser scanner. *See*, FIG. 3(e). As such, Knowles fails to disclose or suggest the steps of determining the authenticity, alteration status, and alteration condition of golf equipment.

Finally, it appears that the Examiner is merely dismissing these factors (authenticity, alteration status, and alteration condition) as nonfunctional descriptive data. Office Action at Page 6. However, in light of the amendments to claims 1 and 30, the determination of authenticity, alteration status, and alteration condition are now functionally involved in the steps. Therefore, since none of the cited combinations disclose or suggest all of the steps of the presently recited method, Applicants respectfully submit that the 35 U.S.C. § 103 rejection is overcome.

### **CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present remarks still do not resolve all of the issues regarding patentability of the pending

claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith extending the time period for response two months to and including September 30, 2010. In addition, a Request for Continued Examination and the requisite fee are submitted. No other fees are believed to be due at this time. Should any other fees be due, please charge them to Deposit Account No. 50-4545, Order No. 5221-043-US01.

Respectfully submitted,  
**HANIFY & KING**  
**Professional Corporation**

Dated: September 30, 2010

By: 

\_\_\_\_\_  
Timothy J. Murphy, Registration No. 62,585

**HANIFY & KING**

**Professional Corporation**

1055 Thomas Jefferson Street, N.W., Suite 400

Washington, D.C. 20007

(202) 403-2115 Telephone

(202) 429-4380 Facsimile